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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shimon S. Shmueli

Serial No. 09/802,634

Filed: 03/09/2001

For: **ACCOUNT PORTABILITY FOR COMPUTING**

Examiner: Fadok, Mark A.

Art Unit: 3625

Mail Stop Appeal Brief - Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

The present **APPEAL BRIEF** is filed in triplicate pursuant to 37 C.F.R. § 1.192.

Applicant also encloses a credit card payment form authorizing payment in the amount of \$500.00 as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is M-Systems Flash Disk Pioneers of Kfar Saba, Israel.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-7, 9-19, and 21-27 are pending and stand rejected, with the rejection made final on August 26, 2004.

Claims 1-7, 9-19, and 21-27 are the subject of the current appeal.

(4) STATUS OF AMENDMENTS

Appellant filed non-substantive amendments on October 5, 2004. The Advisory Action of October 21, 2004 indicates that these amendments were not entered. Appellant proceeds with the appeal with the claims as they were presented prior to the amendments of October 5, 2004.

(5) SUMMARY OF THE INVENTION

The present invention is designed to simplify a user's interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device (10A), such as a card (10B), that has computer readable memory (18) associated therewith. The portable memory device has an appropriate interface (24) through which the portable device may communicate with the computing device (12) during the computing session. The memory contains computer readable software (20) that automatically executes on the computing device (12) during the computing session (page 6, lines 3-25; page 6, line 33-page 7, line 3). In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction (step 122, Figure 3B and page 21, line 21-page 22, line 31). In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the present invention.

To further assist the user, the software of the present invention also removes the financial information from the various memories of the computing device (step 130, Figure 3B and page 11, line 26-page 12, line 11). For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device can not retrieve private information about the previous user.

(6) ISSUES

Whether claims 14 and 19 contain objectionable material.

Whether claims 1, 3-6, 9-13, 15-18, 21, and 23-26 are unpatentable under 35 U.S.C. § 103 over O'Leary et al., in view of Rallis et al., in further view of de la Huerga.

Whether claims 2, 7, 14, 19, 22, and 27 are unpatentable under 35 U.S.C. § 103 over O'Leary et al., in view of Rallis et al., in view of de la Huerga, and further in view of Official Notice.

(7) GROUPING OF CLAIMS

Claims 1-7, 9-13, 15-18, and 21-27 are grouped and stand or fall together, but separately from the other group.

Claims 14 and 19 are grouped and stand or fall together, but separately from the other group.

(8) ARGUMENT

A. Introduction

The combination of references of record does not teach or suggest that financial account information is stored in a portable device for use with a host computing device, as recited in the claims. Since the Patent Office has not shown where the combination of references teaches or suggests all the claim elements, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the application.

B. Standard for Obviousness

1. The Statute

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The Interpretation

To establish *prima facie* obviousness, the Patent Office must show that each and every element of the claim is taught by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. There are essentially three basic ways that an obviousness rejection can be formulated. The first basic way a claim can be rejected under 35 U.S.C. § 103 is through a modified reference. That is, while the reference does not disclose every element of the claim as required under 35 U.S.C. § 102, there is a suggestion to modify the reference to include the missing claim element such that the modified reference teaches each of the claim elements. The

second basic way a claim can be rejected under 35 U.S.C. § 103 is through a combination of references. That is, there is a suggestion to combine two or more references to show all the claim elements. The third way a claim can be rejected under 35 U.S.C. § 103 is through a combination of references, one of which is modified to show a missing claim element. That is, there is an initial suggestion to combine a number of references to teach the majority of the claim elements, and there is a second suggestion to modify this combination of references to include the missing claim element.

It is well recognized that almost every invention is a combination of elements from the prior art. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). One of the things that make an invention patentable is that it would not have been obvious to one of ordinary skill in the art to combine references, modify a reference, or modify a combination of references to arrive at the claimed invention.

The Federal Circuit prohibits the Patent Office from using hindsight reconstruction to arrive at the claimed invention when making an obviousness rejection. *In re Gorman*, 933 F.2d 892 (Fed. Cir. 1991). To help combat the possibility of such hindsight reconstruction, the Federal Circuit established several rules with which the Patent Office must comply when making an obviousness rejection. Initially, the references may not be gathered with the claimed invention in mind. *Pentec, Inc. v. Allen*, 776 F.2d 309, 313 (Fed. Cir. 1985). Furthermore, the Federal Circuit cautions that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). To reconstruct the invention by the selective extraction from the prior art constitutes impermissible hindsight. *In re Gorman*. A reference must be considered for all it teaches. *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992). The Federal Circuit has indicated that the Patent Office cannot remove elements from a reference, and cannot take single elements out of the reference. *Id.* at 1266.

As yet another “defense against the subtle but powerful attraction of a hindsight-based obviousness analysis”, the Federal Circuit has stated that when the Patent Office proposes a combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must provide actual evidence in support of the articulated motivation. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *see also In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). The Federal

Circuit acknowledged that there are myriad sources of support, including the references, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. The “range of sources available, **does not diminish the requirement for actual evidence.**” *In re Dembiczak* at 999 (emphasis added).

The year after *Dembiczak*, the Federal Circuit followed *Dembiczak* by applying the actual evidence requirement to modifications of single references. Specifically, to modify a single reference, the Patent Office must articulate a motivation to modify the reference, and then further support such motivation to modify with actual evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

This is not a new standard, because as early as 1992, the Federal Circuit had applied a similar rule to a modified combination. The Federal Circuit held that even after combination, the combination may not be modified absent an additional showing of a suggestion of the desirability of the modification. *In re Fritch* at 1266 (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

Thus, the Patent Office has several different mechanisms through which it can construct an obviousness rejection, but there are certain rules that the Patent Office must follow in using these mechanisms. Regardless of the nature of the mechanism used, the Patent Office must still teach or suggest all the claim elements. If a claim element is lacking, then the Patent Office has not established *prima facie* obviousness. “If the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

C. Summary of the References

1. O’Leary et al., U.S. Patent 6,609,113

O’Leary et al. (hereinafter “O’Leary”) describes a system that allows for electronic fund transference to effectuate electronic commerce. In particular, the system pushes payments to the payee rather than the payee making a draw against payor’s accounts. In this fashion, the account information of the payor may be kept confidential such that the risk of the account information being compromised is minimized. To accomplish this, O’Leary describes a “digital Wallet” 215 that has a Payment Portal Processor (PPP) which has two addresses associated therewith. The first address is associated with an Internet Pay Anyone (IPA) that sends credits across the Electronic Funds Transfer (EFT) Network. This first address is a private address. The second address is an address at which pushed credits are received from the EFT. This second address

only receives credits, and thus may be published without fear of compromising any secure account information. The user funds the PPP with money, such as from a credit card, and the IPA draws thereagainst when the IPA sends credits out through the EFT.

Important to the system disclosed by O'Leary is that the Wallet 215 is downloaded and installed from a website. However, using "thin wallet technology, the majority of software and databases comprising the Wallet 215 resides on a host web server and the user accesses the Wallet 215 through a website or button (e.g., icon) on the Browser 210." *O'Leary*, column 9, lines 9-15. The Wallet 215, which is primarily on the web server, stores form filling information such as credit card numbers, debit card numbers, shipping addresses, and the like. *O'Leary*, column 9, line 66-column 10, line 13. Using this stored information, the Wallet 215 automatically fills in electronic merchant purchase forms. *O'Leary*, column 10, lines 15-16.

2. Rallis et al., U.S. Patent 6,425,084

Rallis et al. (hereinafter "Rallis") describes a system for providing security for a laptop computer. Specifically, a portable "key" 20 is used at power-up to enable operation. The key holds an encrypted unique serial number, which is selectively used in conjunction with a personal identification number (PIN). At start up, the computer accesses the key 20 to secure authorization to use the computer.

3. de la Huerga, U.S. Patent 5,960,085

de la Huerga describes a security badge that allows selective access to information on a computer. Specifically, the security badge allows a user to login to a computer through an authentication routine. The computer continuously or periodically interrogates the security badge to ascertain whether the security badge is still present. When the security badge is removed from the range of the interrogator, the screen is blanked or the keyboard locked. An extended absence results in the user being logged off automatically. *de la Huerga*, column 4, line 59-column 5, line 10.

After the user is logged off, the system deletes and/or overwrites any files that have been cached on the computer terminal. In particular, the cache associated with the Internet browser may be purged. *de la Huerga*, column 45, lines 11-26.

D. Argument

1. The Combination Does Not Show a Claim Element

The Patent Office opines that the combination of O’Leary, Rallis, and de la Hueraga teaches or suggests all the claim elements. To the contrary, the combination proposed by the Patent Office does not teach or suggest that the financial account information is stored on the portable device as recited in the claims. While each of the claims recites this element, Appellant chooses claim 21 of the application as illustrative. Specifically, claim 21 recites “filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction. . . .”

When the references are combined, the system that is taught by the combination is a portable device (from de la Hueraga or Rallis), such as a security badge (from de la Hueraga), that stores an authentication key that allows the computer to be accessed and used (from de la Hueraga or Rallis). Once the computer is accessed, the user may log in to the digital Wallet on a server through a web browser (from O’Leary). When the user reaches a web site that has financial or shipping forms to be filled, the digital Wallet secures information from the web server associated with the digital Wallet and fills in the fields on the web page (from O’Leary). The system derived from the combination of elements is not the same as Appellant’s claimed invention, which requires that the financial account information be stored on the portable device. Since the combination does not show the claim element, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

In the Patent Office’s analysis of the references and the claims, the Patent Office has not shown the claim element. The Patent Office opines that *O’Leary*, column 4, lines 55-65 and column 5, lines 15-20 teaches “memory within the body containing software and financial account information.” *O’Leary*, column 4, lines 55-65 states in full:

The structural components to the system of the present invention include: a Payment Portal Processor; a digital Wallet; an Internet Pay Anyone (IPA) Account; a Virtual Private Lockbox (VPL); an Account Reporter; the existing EFT networks; and a cash card. The Payment Portal Processor (PPP) is a software application that augments any Internet browser with e-commerce capability. The PPP software sits in front of and provides a secure portal for accessing (linking to) the user’s Demand Deposit Accounts (DDA) and IPA accounts. The PPP enables the user to push electronic credits from its DDA and IPA accounts to any other accounts through the EFT network.

Likewise, *O'Leary*, column 5, lines 15-20 states in full: "The majority of the prior art electronic Wallets on the Internet today are primarily used as a convenience vehicle, merely providing a method of storing account number information and other form filling functions (e.g., shipping addresses)."

While the cited passages do describe the PPP, IPA, and digital Wallet of *O'Leary*, there is no indication that the financial information is actually stored in the personal digital assistant (PDA) of *O'Leary*. In fact, as noted above in the summary of *O'Leary*, *O'Leary* highlights the "thin wallet" nature of the digital Wallet, and indicates that the financial information is not on the PDA, but rather is on the web server remotely positioned from the PDA. See, for example, *O'Leary*, column 9, lines 9-15. Appellant acknowledges that *O'Leary* teaches a wallet that stores financial information, but this wallet does not store financial information on the PDA or "body" of the portable device, as recited in the claims. *O'Leary* clearly teaches the wallet on the server, and the Patent Office's reading of *O'Leary* amounts to an impermissible extraction of an isolated element that ignores *O'Leary*'s teachings with regards to the thin nature of the wallet.

Appellant raised this point in the Response filed October 5, 2004. The Patent Office's response is short and does not illuminate on what basis the Patent Office is ignoring the thin wallet teachings of *O'Leary*. Specifically, the Advisory Action of October 21, 2004 states "Applicant's arguments were not persuasive in overcoming the previous rejection." Such a broad allegation is insufficient to explain how the combination of references shows this element, since *O'Leary* clearly does not teach or suggest that the financial information is stored on the portable device.

Appellant has proven that *O'Leary* does not teach or suggest the recited claim element, and the Patent Office has pointed to no other portion of the other references where such an element is taught or suggested. Since the references individually do not teach or suggest the claim element, the combination cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Appellant further addresses a permutation of the above position. Specifically, the Patent Office may opine that it would be obvious to modify *O'Leary* to include the financial information on the portable device. As noted above, if the Patent Office wishes to modify a

combination, the Patent Office must explain from where the motivation for such a modification comes. *In re Fritch*. Recent case law further indicates that when advancing motivations to modify references or combine references, the Patent Office must present actual evidence to support such motivations. *In re Kotzab*; *In re Dembiczak*. To date, the Patent Office has not provided any motivation to modify the combination such that the financial information is stored on the portable device, nor has the Patent Office provided any actual evidence to support the motivation to modify the combination, such that the financial information is stored on the portable device. Since the Patent Office has not justified the modification to the combination, and the combination does not establish obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

2. Claims 14 and 19 Are Not Objectable

Claims 14 and 19 were objected to because of alleged informalities. Specifically, the Patent Office opines that the dependent claims use reference characters “a” through “c”, but that the underlying independent claims had such reference characters deleted by way of the previous amendment. Appellant notes that the uses of reference characters in the various claims are independent of one another. That is, the use of the reference characters “a”, “b”, and “c” in claim 14 is not a reference to the elements previously labeled “a”, “b”, or “c” in claim 13 (from which claim 14 depends). The elements denoted by reference characters “a”, “b”, and “c” in claim 14 are software instructions for the host computing device as is clearly indicated by the preamble of the claim. Since the reference characters of claim 14 do not refer to the deleted reference characters of claim 13, there is no ambiguity raised by the use of the reference characters in claim 14. As such, the use of the reference characters in claim 14 is not objectionable. The same arguments are true for claim 19, which also depends from claim 13.

Since the use of the reference characters is not objectionable, Appellant requests that the Board instruct the Examiner to withdraw the objection to claims 14 and 19 on this issue. Alternatively, Appellant requests the opportunity to delete the reference characters as Appellant attempted to do in the amendments filed on October 5, 2004, but which were not entered.

E. Conclusion

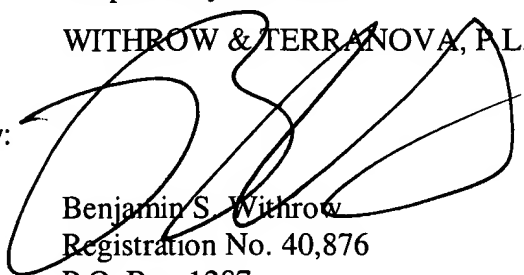
The Patent Office has not shown where in the prior art financial information is stored on the portable device as recited in the claims. Since the Patent Office has not shown this claim element, the Patent Office has not established *prima facie* obviousness. Since the Patent Office

has not established obviousness, the claims are allowable. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Respectfully submitted,

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Name of Depositor

Rebecca Rooks

Signature

1/3/05

Date of Signature

(9) APPENDIX

1. A portable device comprising:

- a) a body;
- b) memory within the body containing software and financial account information;
- c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
- d) the software adapted to execute on the host computing device to instruct the host computing device to:
 - i) recognize financial account fields in a web page during a browsing session;
 - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
 - iii) automatically execute on the host computing device in association with the computing session; and
 - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

2. The portable device of claim 1 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of financial accounts;
- b) receive selected indicia from the user; and
- c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

3. The portable device of claim 1 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.

4. The portable device of claim 1 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.

5. The portable device of claim 1 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.

6. The portable device of claim 1 wherein the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase.

7. The portable device of claim 1 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of shipping addresses;
- b) receive selection indicia from the user; and
- c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

9. The portable device of claim 1 wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device.

10. The portable device of claim 1 wherein the software is adapted to appear as a file system to the host computing device.

11. The portable device of claim 1 wherein the interface is adapted to directly interface a port in the host computing device.

12. The portable device of claim 1 wherein the interface is adapted to provide a wireless interface with the host computing device.

13. A computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices, the software comprising instructions for the host computing device to:

execute on the host computing device during a computing session;

recognize financial account fields in a web page during a browsing session; and

fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction,

said software further adapted to execute automatically on the host computing device in association with the computing session, and

in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

14. The computer readable medium of claim 13 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of financial accounts;
- b) receive selection indicia from the user; and
- c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

15. The computer readable medium of claim 13 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.

16. The computer readable medium of claim 13 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.

17. The computer readable medium of claim 13 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that the user may use the bookmark to efficiently access the web site via the browser.

18. The computer readable medium of claim 13 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and

provide the shipping information to the web site to facilitate delivery of the item selected for purchase.

19. The computer readable medium of claim 13 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of shipping addresses;
- b) receive selection indicia from the user; and
- c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

21. A method for facilitating a web-based transaction using a portable device capable of interacting with a plurality of host computing devices, the method comprising:

- a) executing software resident on the portable device on a host computing device in association with a computing session:
- b) recognizing financial account fields in a web page during a browsing session;
- c) filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction; and
- d) remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session.

22. The method of claim 21 wherein the financial account information relates to a plurality of financial accounts, the method further comprising:

- a) querying the user to select one of the plurality of financial accounts;
- b) receiving selection indicia from the user; and

c) filling in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

23. The method of claim 21 further receiving authentication indicia from a user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored on the portable device.

24. The method of claim 21 wherein the portable device stores login information for a web site associated with the web-based transaction and further comprising determining if login information is necessary for the web site and providing the login information upon entering the website.

25. The method of claim 21 wherein a bookmark for the website is stored on the portable device and further comprising making the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.

26. The method of claim 21 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and further comprising accessing the shipping information and providing the shipping information to the web site to facilitate delivery of the item selected for purchase.

27. The method of claim 21 wherein the shipping information includes a plurality of shipping addresses and further comprising:

- a) querying a user to select one of the plurality of shipping addresses;
- b) receiving selection indicia from the user; and

c) filling in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.